132-215

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1889.

No. 1198.

THE OREGON IMPROVEMENT COMPANY, PLAINTIFF IN ERROR,

vs.

THE EXCELSIOR COAL COMPANY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF CALIFORNIA.

FILED AUGUST 14, 1889.

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JUDD & DETWEILER, PRINTERS, WASHINGTON, AUGUST 15, 1889.

1 *Complaint.*

In the Circuit Court of the United States, Northern District of California, Ninth Circuit.

THE EXCELSIOR COAL CO. (a Corporation), Plaintiff,
vs.
THE OREGON IMPROVEMENT CO. (a Corporation), Defendant.

The said Excelsior Coal Company, as plaintiff, complains of the said defendant, The Oregon Improvement Company, and for cause of action alleges—

That the said plaintiff and the said defendant are each of them a corporation organized and doing business under the laws of the State of California.

That heretofore, to wit, before the 26th day of April, A. D. 1873, one Martin R. Roberts was the original and first inventor of a certain new and useful invention entitled "improvements in coal screens and chutes."

That prior to the invention thereof by said Martin R. Roberts the said invention was not known or used by others, and at the time of his application for a patent therefor said invention had not been in public use or on sale in this country for two years, nor abandoned.

That, being so as aforesaid the inventor thereof, said Martin R. Roberts, did, on the said 26th day of April, 1873, make due and formal application to the Patent Office of the United States for a patent therefor, and on the 17th day of June, 1873, in pursuance of said application, letters patent of the United States numbered 140,077 was [were] issued and delivered to said Martin R. Roberts by the Commissioner of Patents of the United States for the said invention, granting and securing to said Martin R. Roberts, his heirs or assigns, for the full term of seventeen years from the last-named date the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said invention throughout the United States and territories thereof.

2 That said letters patent were issued in due form of law, under the seal of the Patent Office of the United States, and were signed by the Secretary of the Interior and countersigned by the Commissioner of Patents of the United States, and bore date the day and year last aforesaid.

That afterwards, to wit, on the 10th day of October, A. D. 1876, upon due application therefor and upon the surrender to the Commissioner of Patents of the United States of the letters patent last aforesaid, new letters patent were duly issued to said Martin R. Roberts for the same invention for the residue of the term then unexpired for which the said original letters patent was [were] granted. That the letters patent so issued were issued in due form of law, under the seal of the Patent Office, and were signed by the Secretary of the Interior and countersigned by the Commissioner of

Patents of the United States, and were dated the day and year last aforesaid, and were delivered to the said Martin R. Roberts, whereby there was secured to him, his heirs and assigns, for the residue of said term of seventeen years from said 17th day of June, 1873, the full and exclusive right and liberty of making, constructing, using, and vending to others to use the said invention hereinbefore mentioned, a description whereof and of said invention more fully appears in said letters patent; which said letters patent are ready in court to be produced by this plaintiff or a duly authenticated copy thereof.

That prior to the issue of said original letters patent, and also prior to the issue of said reissued letters patent, all proceedings were had and taken which were required by law to be had or taken previous to the issue and reissue, respectively, of letters patent granting special rights and liberties for new inventions.

That by a regular chain of assignments, duly recorded in the United States Patent Office, all the right, title, and interest in said invention, and letters patent were granted and conveyed to the plaintiff herein before the 1st day of November, 1877; ever since which last-named date plaintiff has been and is now the sole owner of said letters patent and invention and of all rights and privileges granted thereunder.

That heretofore, to wit, before the 15th day of Nov., A. D.
3 1875, B. La Count Satterfield, Charles L. Crisman, and James McKinley were the original, first, and joint inventors of certain new and useful improvements in coal screens and chutes.

That the same was not known or used by others before the invention thereof by the said B. La Count Satterfield, Charles L. Crisman, & James McKinley, and at the time of their application for a patent therefor, as hereinafter stated, has not been in public use or on sale for two years, nor abandoned.

That being the inventors thereof, upon due application made therefor, letters patent of the United States numbered 176,070 were, on the 11th day of April, A. D. 1876, duly issued to the said B. La Count Satterfield, Charles L. Crisman, & James McKinley, granting and securing to them, their executors, administrators, or assigns, for the full term of seventeen years from the last-named date, the full and exclusive right and liberty of making, using, and vending to others to be used the said invention and improvement throughout the United States and the territories thereof.

That said letters patent were issued in due form of law, under the seal of the Patent Office of the United States, and were signed by the Secretary of the Interior and countersigned by the Commissioner of Patents of the United States, and bore date the day and year last aforesaid, a description whereof and of said invention more fully appears in said letters patent; which said letters patent are ready in court to be produced by this plaintiff or a duly authenticated copy thereof.

That prior to the issuing of said letters patent all proceedings were had and taken which were required by law to be had or taken

previous to the issuance of letters patent granting special rights and liberties for new and useful inventions.

That by a regular chain of assignments, in writing and recorded in the United States Patent Office, said letters patent and all privileges, rights, and liberties by it conferred were, on or about the 1st day of Nov., 1877, assigned and conveyed to the plaintiff herein.

That from the time the plaintiff became the owner of the letters patent up to the present time plaintiff has been constantly in the exercise of the rights and privileges thereby granted and
4 conferred and has used the said patented machine for itself, and has always been ready and willing to rent or let the said patented machine on a royalty to those desiring to screen coal.

That each of said patents cover and describe and claim improvements in machines for screening coal, and the invention and improvements thus described and claimed are capable of being united and used in the construction of a single coal-screening machine.

Yet the said defendant, well knowing the premises, but contriving to injure the plaintiff, has since the 1st day of January, 1880, unlawfully and wrongfully and without the consent or allowance and against the will of plaintiff, constructed, made, and used a large number of coal screens such as is described in said letters patent; which said coal screens, each of which, contain the features or some of them described and claimed in each of said letters patent, which said machines and each of them is a violation and infringement upon the rights and privileges secured to the plaintiff by said letters patent, and thence hitherto the said defendant has continued to make and use said patented improvements and inventions within the State of California and within the jurisdiction of this honorable court, in violation and infringement of the exclusive privileges, rights, and liberties secured to the plaintiff as aforesaid and contrary to the law and the form of the statutes in such cases made and provided.

And plaintiff says that on account of the said acts of the defendant it, the plaintiff, has been greatly injured and damaged and deprived of great profits which it might and otherwise would have derived from the said invention and letters patent, and has sustained actual damages to the amount of one hundred thousand dollars, and by force of the statute aforesaid an action has accrued to plaintiff to recover the said actual damages as the court may see fit to order and adjudge.

Wherefore plaintiff prays judgment against the said defendant for the sum of one hundred thousand dollars actual damages, together with such further sum, not exceeding in the aggregate three times the amount of said actual damages, and for such other and further relief as it may be entitled to have in a court of law, and for costs of suit.

SCRIVNER & BOONE,
Attorneys for Plaintiff.

5 I hereby certify that the foregoing is a true and correct copy of the original complaint filed herein.

JNO. L. BOONE,
Attorney for Plaintiff.

Endorsed: Filed September 13, 1887. L. S. B. Sawyer, clerk.

6 *Answer.*

In the Circuit Court of the United States, Northern District of California, Ninth Circuit.

THE EXCELSIOR COAL CO., Plaintiff,
vs.
THE OREGON IMPROVEMENT CO., Defendant.

Now comes the defendant and, answering the complaint on file in the above-entitled action, denies each and every, all and singular, the allegations therein contained.

And, further answering said complaint, the defendant says that the apparatus covered by the reissue letters patent issued to Martin R. Roberts on the 10th day of October, 1876, was not an invention when produced by the said Martin R. Roberts.

And, further answering said complaint, the defendant says that the apparatus covered by the letters patent issued to B. La Count Satterfield, Charles L. Crisman, and James McKinley was not an invention when produced by the said Satterfield, Crisman, and McKinley.

Wherefore the defendant prays to be hence dismissed with its costs.

SIDNEY V. SMITH,
Attorney for Defendant.

Endorsed: Service of a copy of the within answer is hereby admitted this 1st day of December, 1887. Scrivner & Boone, plaintiff's attorneys. Filed December 1st, 1887. L. S. B. Sawyer, clerk.

7 *Verdict.*

UNITED STATES OF AMERICA:

Circuit Court of the United States, Ninth Judicial Circuit, Northern District of California.

EXCELSIOR COAL COMPANY
vs.
OREGON IMPROVEMENT COMPANY. } No. 5209.

We, the jury, find in favor of the plaintiff, and assess the damages at the sum of seven thousand dollars, $7,000.00.

JOHN HOMES, *Foreman.*

Endorsed: Filed Sept. 18, 1888. L. S. B. Sawyer, clerk, by F. D. Monckton, deputy clerk.

8 *Certified Copy of Judgment.*

UNITED STATES OF AMERICA:

Circuit Court of the United States, Ninth Judicial Circuit, Northern District of California.

EXCELSIOR COAL COMPANY
vs.
OREGON IMPROVEMENT COMPANY. } No. 5209.

This cause having come on regularly for trial on the 29th day of August, 1888, being a day in the July, 1888, term of said court, before the court and a jury of twelve men, duly impaneled, J. J. Scrivner and J. L. Boone, Esq's, appearing on behalf of the plaintiff and Sidney V. Smith and J. H. Boalt, Esq's, on behalf of the defendant, and the trial having been proceeded with upon the 30th and 31st days of said August and the 4th, 5th, 11th, 12th, 13th, 14th, and 18th days of September of said term and year, and witnesses on the part of the plaintiff and of the defendant having been sworn and examined, and evidence, oral and documentary, on behalf of the respective parties hereto having been introduced and closed, and the cause, after argument of counsel and the instructions of the court, having been submitted to the jury, and the jury having subsequently rendered the following verdict:

"We, the jury, find in favor of the plaintiff, and assess the damages at the sum of seven thousand dollars;"

And the court having thereupon ordered that judgment be entered herein in accordance with said verdict, and for costs:

Now, therefore, by virtue of the law and by virtue of the premises aforesaid, it is concluded by the court that The Excelsior Coal Company, plaintiff, do have and recover of and from The Oregon Improvement Company, defendant, the sum of seven thousand dollars and its costs in this behalf expended, taxed at $43.60.

Judgment entered September 18, 1888.

L. S. B. SAWYER, *Clerk.*

[SEAL.] A true copy.
Attest, &c. L. S. B. SAWYER, *Clerk.*

Endorsed: Filed September 18, 1888. L. S. B. Sawyer, clerk.

9 *Clerk's Certificate.*

In the Circuit Court of the United States, Ninth Judicial Circuit, in and for the Northern District of California.

EXCELSIOR COAL COMPANY
vs.
OREGON IMPROVEMENT CO. } No. 5209.

I, L. S. B. Sawyer, clerk of the circuit court of the United States for the ninth judicial circuit, northern district of California, do

hereby certify that the foregoing papers, hereto annexed, constitute the judgment-roll in the above-entitled action.

Attest my hand and the seal of said circuit court this 18th day of Sept., 1888.

[SEAL.] L. S. B. SAWYER, *Clerk*,
By F. D. MONCKTON,
Deputy Clerk.

Endorsed: Judgment-roll. Filed Sept. 18th, 1888. L. S. B. Sawyer, clerk, by F. D. Monckton, deputy clerk.

10 *Defendant's Bill of Exceptions.*

In the Circuit Court of the United States in and for the Ninth Circuit, Northern District of California.

EXCELSIOR COAL COMPANY, Plaintiff,
vs.
OREGON IMPROVEMENT COMPANY, Defendant.

Be it remembered that at the regular July term of the above-named court for the year 1888, held at the city and county of San Francisco, State of California, the above-entitled action, on the 29th day of August, 1888, came on regularly for trial before the court and a jury selected and impanelled to try the same, Messrs. Scrivner and Boone appearing as counsel for plaintiff and Sidney V. Smith, Esq., as counsel for defendant.

Whereupon the plaintiff, to sustain the issues on its part, offered and read in evidence without objection reissued letters patent number 7341, dated October 10th, 1876, in the words and figures following:

11 UNITED STATES PATENT OFFICE.

MARTIN R. ROBERTS, of San Francisco, California.

Improvement in Coal Screens and Chutes.

Specification forming part of Letters Patent No. 140,077, dated June 17, 1873; Reissue No. 6211, dated January 5, 1875; Reissue No. 7341, dated October 10, 1876; application filed July 10, 1876.

To all whom it may concern:

Be it known that I, Martin R. Roberts, of the city and county of San Francisco and State of California, have invented certain new and useful improvements in a combined portable hopper, chute, and screening apparatus; and I do hereby declare the following description and accompanying drawings are sufficient to enable any person skilled in the art or science to which it most nearly appertains to make and use my said invention without further invention or experiment.

Previous to my invention, in unloading vessels of coal the coal has, for the most part, been hoisted from the hold over the bulwarks, and dumped upon the wharf or upon the coal previously dumped, or, if chutes were used, such chutes were fixed; nor, so far as I am aware, has a movable chute ever been known or used by which the coal could be received from the vessel at any point in the wharf, and be screened and delivered to the cart.

My invention consists of a portable apparatus for receiving coal from the bucket by which it is hoisted from the hold of a ship, and for screening and delivering it to carts on the wharf, said apparatus being adapted for ready removal from place to place, when required.

By this apparatus I am able to save repeated handlings and consequent expense, and the breakage of the coal, and the apparatus can be changed from one point to another where the vessel may be placed.

There are further and subordinate objects to be secured by my invention, and the improved details devised for these purposes will be set forth more fully hereafter.

In the drawings, A A represent a strong frame, which is properly stayed and braced, so as to withstand the concussions to which it will be subjected. At one side of the top of this frame I secure two boards, B B′, at an obtuse angle to each other, in the form of a trough, but leave their lower ends separated, so as to provide a space, C, between them, for the purpose hereinafter described. These boards form what I call the hopper. The board B′ forms an extension to one side, D, of a large reservoir, O, which is located in the body of the frame below the hopper. This side D of the large reservoir slopes toward the opposite side of the frame, and is constructed of parallel wires, secured at short distances apart, so as to form a screen over which the coal or other substance must pass in descending from the hopper to the reservoir, and through which the small particles up to a certain size will fall, leaving the larger pieces, which cannot pass through the screen, lying in the second or large hopper. The reservoir is contracted toward its lower end, and a chute, F, extends from it out over the opposite side of the frame from that on which the upper hopper is located. A gate, *h*, which will be more fully described hereafter, serves to retain the coal in the chute and reservoir until it is desired to allow it to pass from the chute into the cart or other vehicle. An independent grate or screen, I, of finer mesh than the grate D, is secured in an inclined position in the frame A A, below the screen D, so as to receive the particles of coal or other substance which pass through the upper screen, and which serves to again separate it into two grades. This screen stands at an angle transversely to the upper screen, so that the particles which pass down it, on account of not being small enough to pass through the meshes, will be carried off to one side of the machine, while the finer portions which pass through the screen will fall upon the floor or wharf directly under the frame. Two or more of these screens can be used, and the size of the meshes can be varied according to the substance to be cleaned and the number and quality of the grades into which it is desired to separate the substance being discharged.

The frame A A will be mounted upon small wheels, so that it can be moved from one place to another upon a wharf, in order to be placed in position to receive the discharging cargo of different ships; but when moving it from one wharf to another, I em-
12 ploy axles across each end of the frame, upon which strong wheels are placed, so that the entire machine can be drawn along similar to any vehicle.

The hopper B B′ is as long as the machine, and is made wide, so that when ordinary care is used in dumping it is certain to catch all the coal poured from the swinging tub. This hopper is also placed high on the machine, and but slightly above the inclined side of the reservoir, so that the coal has but a short distance to fall, and is thereby prevented from being broken and pulverized. The outlet of the hopper B B′ extends entirely across the upper end of the side or screen D, by which arrangement the passing coal is distributed over the entire width of D, and has to pass its entire length, thus insuring a thorough screening of the coal. The construction and location of this hopper B B′ make it a success in receiving the contents of the bucket by which the coal is hoisted from the hold of the vessel, a result which I believe was never before accomplished by any hopper.

By placing the reservoir O in its peculiar position, and making it large, several advantages are obtained. Among others, a large screening surface is obtained. The gate *h* is sufficiently high from the wharf to allow vehicles to be placed so as to receive the coal direct as it is discharged from the chute, so as to save reloading it from the wharf; and the reservoir O is large enough to serve as a store-room, so that, in case of temporary delay in the vehicle carrying the coal to the yards, the work of unloading the ship or other vessel can proceed without the necessity of piling the coal upon the wharf.

When it is not desired to screen the article or substance to be unloaded, a false bottom or metal blank, K, is placed upon the grating or inclined side D of the reservoir, so that the substance will be carried directly through the chute into the cart or wagon intended to convey it away.

The gate or cut-off which I use consists of a lever-bar, *p*, which has one end pivoted to the frame, so that it will extend transversely across above the end of the chute. Metal teeth *h* extend downward across the mouth of the chute, so as to bar the entrance. When the cart is in position beneath the chute, the free end of the lever is raised so as to clear the teeth from the mouth of the chute, and allow the substance to pass through by its gravity into the cart.

From the practical success which has attended my invention, I believe its introduction will make it profitable to ship other substances, such as cobble-stones, gravel &c., and assort them while unloading the ship.

By this arrangement coal can be discharged from ships, screened, and loaded into the carts not only at a great saving of expense in handling it, but with less wastage, as the large and more marketable pieces or lumps will not be broken when dumped in this ma-

M. R. ROBERTS. 13

COAL-SCREENS AND CHUTES.

No. 7,341. Reissued Oct. 10, 1876.

No. 1198.
Oliles
C.C. Co. } h. 13

Fig 1

Defendants
Bill of
Exceptions

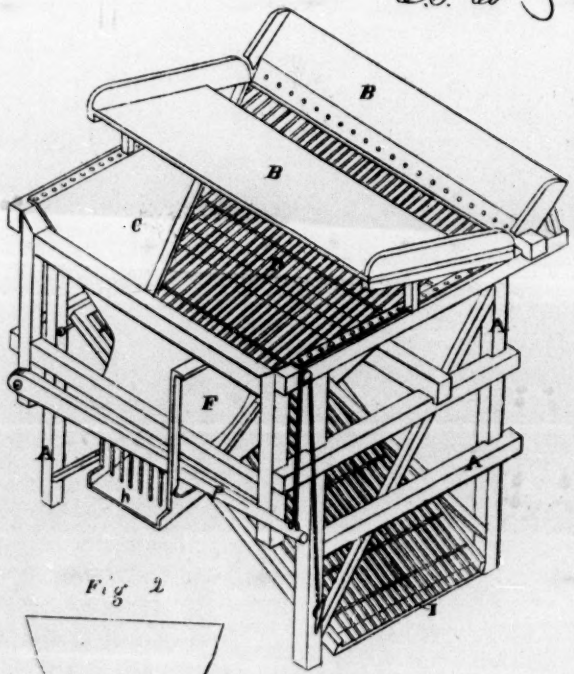
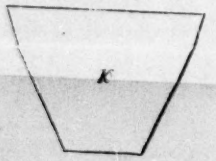


Fig 2



Witnesses
Jno L. Boone
Chas G. Page

Inventor.
Martin R. Roberts
by Dewey & Co
Attys

chine, as they always are, to a greater or less extent, when dumped from the height of twenty or thirty feet upon the wharf or coal-pile.

Having described my invention, what I claim, and desire to secure by letters patent, is—

1. A portable combined coal receiving, screening, and delivering apparatus arranged to receive the coal or other cargo from a swinging suspended tub or bucket, by which it is hoisted from the hold of a ship or other water-craft, and to screen it automatically and deliver it into carts, said apparatus being constructed and arranged substantially as described.

2. The receiving-hopper B B′, in combination with the reservoir O, with its screen or grating side D, chute F, with its toothed gate *h*, and one or more independent screens, I, all combined and arranged substantially as and for the purpose above described.

3. The metal blank or false bottom K, in combination with the receiving-hopper B B′, reservoir O, chute F, and gate *h*, substantially as and for the purpose above described.

4. The combination of the hopper B B′, for receiving the coal from a swinging bucket, the reservoir O, arranged to receive the coal as it passes from the hopper, with the chute F and gate *h*, all constructed to operate substantially as and for the purpose set forth.

5. In combination with the elongated hopper, the screen D, reservoir O, and chute F, with its gate *h*, the combination being substantially as is herein set forth.

MARTIN R. ROBERTS.

Witnesses:
J. L. BOONE.
CHAS. G. PAGE.

(Here follows diagram marked p. 13.)

14 in favor of Martin R. Roberts.

The plaintiff then proved that by a regular chain of assignments, duly recorded in the United States Patent Office, all the right, title, and interest in the invention described in said reissued letters patent and in said reissued letters patent were granted and conveyed to the plaintiff before November 1st, 1877, and that the plaintiff ever since then has been and is now the sole owner of the said letters patent and invention.

The plaintiff then introduced evidence tending to prove that the defendant had, since January 1st, 1880, in the said city and county of San Francisco and in the city of Oakland, in said State, infringed upon the rights and privileges secured to the plaintiff by said reissued letters patent by making and using a large number of coal screens and chutes, such as are described in said reissued letters patent.

The plaintiff then introduced evidence tending to show the amount of damage done to it by the defendant's said infringement.

The plaintiff then rested.

Exception No. 1.

Whereupon the defendant, to sustain the issues on its part, offered in evidence a duly certified copy of the original letters patent number 140,077, dated June 17th, 1873, in favor of Martin R. Roberts, for an improvement in coal screens and chutes; which original letters patent are in the words and figures following:

15 UNITED STATES PATENT OFFICE.

MARTIN R. ROBERTS, of San Francisco, California.

Improvement in Coal Screens and Chutes.

Specification forming part of Letters Patent No. 140,077, dated June 17, 1873; application filed April 26, 1873.

To all whom it may concern:

Be it known that I, Martin Rickard Roberts, of San Francisco city and county, State of California, have invented a combined portable hopper, chute and screening apparatus; and I do hereby declare the following description and accompanying drawings are sufficient to enable any person skilled in the art or science to which it most nearly appertains to make and use my said invention or improvement without further invention or experiment.

My invention relates to a portable apparatus which is intended more particularly for receiving, cleaning and delivering into carts, coal and other like substances, which are usually dumped upon the wharf in discharging ships.

The usual method of discharging ships of their cargo of coal is to raise the coal from the vessel in tubs by a steam hoisting apparatus, and dump it in a pile upon the wharf, from which it is removed by carts to the different coal-yards, where it is screened so as to separate the finer portion or screenings from the large and marketable or more merchantable portion.

My invention consists of a portable apparatus having a double hopper, chute, and screens, so arranged that by dumping the coal or other substances to be handled from the tub into the upper hopper the fine portions or small particle will be separated in two or more grades from the coarser portions, and be deposited in separate piles, while the coarser pieces are caught in the second hopper, from which they can be conveyed through a chute into the carts which convey them to the coal-yards, thus requiring but one operation to discharge the cargo, screen the coal, and load it into the carts.

In order to more fully illustrate and explain my invention, reference is had to the accompanying drawings, forming a part of this specification, in which—

Figure I is a perspective view of my invention. Fig. II is a plan view of the blank to be used when the apparatus is used only as a chute.

A A represent a strong frame, which is properly stayed and

braced so as to withstand the concussions to which it will be subjected. At one side of the top of this frame, I secure two boards, B B′, at an obtuse angle to each other, in the form of a trough, but leave their lower ends separated so as to provide a space, C, between them for the purpose hereinafter described. These boards form what I call the upper hopper. The board B′ forms an extension to one side, D, of a large hopper, O, which is located in the body of the frame below the upper hopper. This side D of the large hopper slopes toward the opposite side of the frame, and is constructed of parallel wires secured at short distances apart, so as to form a screen over which the coal or other substance must pass in descending from the upper to the lower hopper, and through which the small particles, up to a certain size, will fall, leaving the larger pieces, which cannot pass through the screen, lying in the second or large hopper. The lower hopper is contracted toward its lower end, and a chute, F, extends from it out over the opposite side of the frame from that on which the upper hopper is located. A gate, *h*, which will be more fully described hereafter, serves to retain the coal in the chute and hopper until it is desired to allow it to pass from the chute into a cart or other vehicle. An independent grate or screen, I, of finer mesh than the grate D, is secured in an inclined position in the frame A A, below the screen D, so as to receive the particles of coal or other substance which pass through the upper screen, and which serves to again separate it into two grades. This screen stands at an angle transversely to the upper screen, so that the particles which pass down it on account of not being small enough to pass through the meshes will be carried off to one side of the machine, while the finer portions, which pass through the screen, will fall upon the floor or wharf directly under the frame.

Two or more of these screens can be used, and the size of the meshes can be varied according to the substance to be cleaned
16 and the number and quality of the grades into which it is desired to separate the substance being discharged.

The frame A A will be mounted upon small wheels, so that it can be moved from one place to another upon a wharf in order to be placed in position to receive the discharging cargo of different ships; but when moving it from one wharf to another, I employ axles across each end of the frame, upon which strong wheels are placed, so that the entire machine can be drawn along similar to any wheeled vehicle.

The upper trough, which is formed by the boards B B′, is as long as the machine, so that in dumping the load any vibration or swinging of the tub while it is being emptied will not cause the load to be discharged outside of the hopper as long as the machine is properly located and ordinary care is exercised in dumping it. This form of the upper hopper also allows the substance which is dumped into it to spread over a larger surface and thus be more thoroughly screened than when the hopper is smaller.

When it is not desired to screen the article or substance to be unloaded, a false botton or metal blank, K, is placed upon the grating or inclined side D of the larger hopper, so that the substance will

be carried directly through the chute into the cart or wagon intended to convey it away.

The gate or cut-off which I use consists of a lever bar, *p*, which has one end pivoted to the frame, so that it will extend transversely across above the end of the chute. Metal teeth, *h*, extend downward across the mouth of the chute, so as to bar the entrance. When the cart is in position beneath the chute, the free end of the lever is raised so as to clear the teeth from the mouth of the chute, and allow the substance to pass through by its gravity into the cart.

By this arrangement coal can be discharged from ships, screened and loaded into carts, not only at a great saving of expense in handling it, but with less wastage, as the large and more marketable pieces or lumps will not be broken when dumped into this machine, as they always are, to a greater or less extent, when dumped from the height of twenty or thirty feet upon the wharf or coal pile.

Having thus described my invention, what I claim, and desire to secure by letters patent, is—

1. The receiving-hopper B B′, in combination with the hopper O, with its screen or grating side D, chute F, with its toothed gate *h*, and one or more independent screens I, all combined and arranged substantially as and for the purpose above described.

2. The metal blank or false bottom K, in combination with the receiving-hopper B B′, hopper O, chute F, and gate *h*, substantially as and for the purpose above described.

In witness whereof I hereunto set my hand and seal.

M. R. ROBERTS. [L. S.]

Witnesses:
GEO. H. STRONG.
HENRY K. MOORE.

(Here follows diagram marked p. 17.)

18 Whereupon counsel for the plaintiff objected to the introduction of said original letters patent on the ground that the same was [were] immaterial and irrelevant to any defence raised by the answer,

The court sustained the objection.

To which ruling of the court counsel for defendant then and there duly excepted, and tendered this his bill of exceptions to the court to sign and seal, and the court did thereupon sign and seal the same.

The court then charged the jury, who then retired, and after deliberation brought in a verdict for the plaintiff, and assessed its damages at seven thousand dollars.

And now, in furtherance of justice and that right may be done, the defendant presents the foregoing as its bill of exceptions in said case, and prays that the same may be settled and allowed and signed and certified by the judge, as provided by law.

SYDNEY V. SMITH,
Attorney for Defendant.

M. R. ROBERTS.

Coal-Screens and Chutes.

No. 140,077 Patented June 17, 1873

No. 1198.
O. I. Leo
C. & L. Leo. } Ex. 17

Defendants' Bill
of Exceptions

Fig. I.

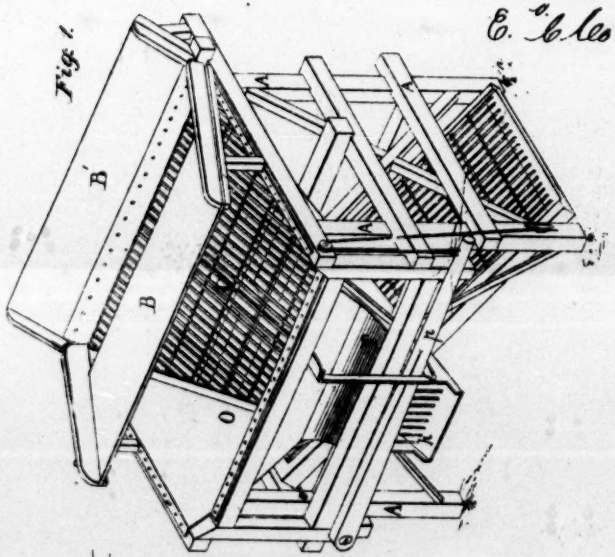
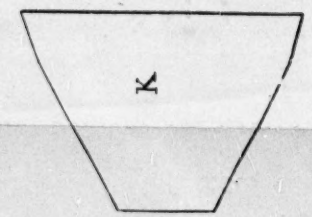


Fig. II.



Witnesses.
R. H. Whittlesey
D. D. Brown

Inventor.
Martin R. Roberts
by A. H. R. K. & Co.
his Attys.

The foregoing bill of exceptions is allowed and settled.

GEO. M. SABIN,
Dist. Judge, Dist. of Nevada, Presiding.

Endorsed: Service of a copy of within bill of exceptions is hereby admitted this 25th day of April, 1889. Scrivner & Boone, att'ys for plaintiff. Filed May 3rd, 1889. L. S. B. Sawyer, clerk, by F. D. Monckton, deputy clerk.

19 *Bond on Writ of Error.*

In the Supreme Court of the United States.

EXCELSIOR COAL COMPANY, Defendant in Error,
vs.
OREGON IMPROVEMENT COMPANY, Plaintiff in Error.

Know all men by these presents that we, The Oregon Improvement Company, a corporation, as principal, and Charles Goodall and George C. Perkins, of the State of California, as sureties, are held and firmly bound unto the Excelsior Coal Company, a corporation of the State of California, in the sum of ten thousand dollars, to be paid to the said Excelsior Coal Company, its successors or assigns; to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our successors, assigns, executors, and administrators, firmly by these presents.

Sealed with our seals. Dated this 21st day of December, 1888.

Whereas the above-named Oregon Improvement Company has prosecuted a writ of error in the Supreme Court of the United States to reverse the judgment rendered in the above-entitled action by the circuit court of the United States in and for the northern district of California, ninth circuit:

Now, therefore, the condition of this obligation is such that if the above-named Oregon Improvement Company shall prosecute its said writ of error to effect and shall answer all costs and damages if it fail to make its plea good, then this obligation shall be void; otherwise to remain in full force and virtue.

CHARLES GOODALL.
GEO. C. PERKINS.

Signed, sealed, and delivered in the presence of—
L. S. B. SAWYER.

20 UNITED STATES OF AMERICA, } ss:
Northern District of California,

Charles Goodall and George C. Perkins, being duly sworn, depose and say and each for himself says that he is worth the sum of ten thousand dollars over and above all his just debts and liabilities.

CHAS. GOODALL.
GEO. C. PERKINS.

Subscribed and sworn to before me this 21st day of December, 1888.

L. S. B. SAWYER,
Commissioner U. S. Circuit Court,
Northern District of California.

I hereby approve the above bond and the sufficiency of the sureties thereto.

GEO. M. SABIN, *Judge.*

Endorsed: Filed Dec'r 21, 1888. L. S. B. Sawyer, clerk.

21 In the Circuit Court of the United States, Ninth Judicial Circuit, Northern District of California.

THE EXCELSIOR COAL COMPANY, Plaintiff and Defendant in Error,
vs.
THE OREGON IMPROVEMENT COMPANY, Defendant and Plaintiff in Error.
} No. 5209.

I, L. S. B. Sawyer, clerk of the circuit court of the United States, ninth judicial circuit, northern district of California, do hereby certify that the foregoing twenty (20) written and printed pages, hereto annexed, are a full, true, and correct copy of the record and proceedings in the above-entitled action, and that the same together constitute the return to the annexed writ of error.

In witness whereof I have hereunto set my hand and affixed the seal of said circuit court this 14 day of June, A. D. 1889.

[Seal U. S. Circuit Court, Northern Dist. Cal.]

L. S. B. SAWYER, *Clerk.*

22 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the judges of the circuit court of the United States, ninth circuit, northern district of California, Greeting:

Because in the record and proceedings and also in the rendition of the judgment of a plea which is in the said circuit court, before you, between The Oregon Improvement Company, a corporation, plaintiff in error, and The Excelsior Coal Company, a corporation, defendant in error, a manifest error hath happened, to the great damage of the said Oregon Improvement Company, as by its complaint appears, and it being fit that the error, if any there hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at the city of Washington, in the District of Columbia, on the second Monday of October next, in the said Supreme Court to be there and then

held, that, the record and proceedings aforesaid be [being] inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the law and custom of the United States should be done.

Witness the Hon. Melville W. Fuller, Chief Justice of the Supreme Court of the United States, this 21st day of December, in the year of our Lord one thousand eight hundred and eighty-eight, and of the Independence of the United States the one hundred and thirteenth.

[Seal U. S. Circuit Court, Northern Dist. Cal.]

L. S. B. SAWYER,
Clerk U. S. Circuit Court, Nor. Dist. Cal.

The above writ of error is hereby allowed.

GEO. M. SABIN,
Acting Circuit Judge.

23 [Endorsed:] 5209. United States Supreme Court. Oregon Improvement Company, plaintiff in error, *vs.* Excelsior Coal Company, defendant in error. Writ of error. Filed December 21st, 1888. L. S. B. Sawyer, clerk U. S. circuit court, northern district of California.

The Answer of the Judges of the Circuit Court of the United States, Ninth Circuit, Northern District of California.

The record and proceedings of the plaint whereof mention is within made, with all things touching the same, we certify, under the seal of our said court, to the Supreme Court of the United States of America, within mentioned, at the day and place within contained, in a certain schedule to this writ annexed, as within we are commanded.

By the court:

[Seal U. S. Circuit Court, Northern Dist. Cal.]

L. S. B. SAWYER, *Clerk.*

24 UNITED STATES OF AMERICA, *ss:*

To Excelsior Coal Company, Greeting:

You are hereby cited and admonished to be and appear at the Supreme Court of the United States, to be held at the city of Washington, in the District of Columbia, on the fourteenth day of October, A. D. 1889, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States, ninth circuit, northern district of California, wherein Oregon Improvement Company is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected and speedy justice should not be done to the parties in that behalf.

Witness the Honorable George M. Sabin, judge of the circuit court of the United States, ninth circuit, northern district of California,

this 21st day of December, A. D. 1888, and of the Independence of the United States the one hundred and thirteenth.

GEO. M. SABIN, *Judge.*

25 [Endorsed:] No. 5209. In the Supreme Court of the United States. Oregon Improvement Company, plaintiff in error, *vs.* Excelsior Coal Company, defendant in error. Citation. Filed February 6th, 1889. L. S. B. Sawyer, clerk U. S. circuit court, northern district of California.

Service of the within citation by receipt of a copy thereof is hereby admitted this first day of February, 1889.

SCRIVNER & BOONE,
Attorneys for Plaintiff.

26 In the Supreme Court of the United States.

OREGON IMPROVEMENT COMPANY, Plaintiff in Error, *vs.* EXCELSIOR COAL COMPANY, Defendant in Error.	In Error, of October Term, 1889.

Afterwards, to wit, on the second Monday of October, in this same term, before the justices of the Supreme Court of the United States, at the Capitol, in the city of Washington, comes the said Oregon Improvement Company, by its attorney, Sidney V. Smith, and says that in the record and proceedings aforesaid there is manifest error, in this, to wit:

That the court refused to allow the plaintiff in error to introduce in evidence to sustain the issues on its part the aforesaid duly certified copy of the original letters patent number 140,077, dated June 17th, 1873, in favor of the aforesaid Martin B. Roberts, for an improvement in coal screens and chutes.

And the said Oregon Improvement Company prays that the judgment aforesaid may be reversed, annulled, and altogether held for nothing, and that they be restored to all things which they have lost by occasion of the said judgment, &c.

SIDNEY V. SMITH,
Attorney for Plaintiff in Error.

27 [Endorsed:] No. —. Dep. No. —. In the Supreme Court of the United States. Oregon Improvement Co., plaintiff in error, *vs.* Excelsior Coal Company, defendant in error. Assignment of error. Personal service of the within assignment of error by delivery of a copy thereof is admitted this May 13th, 1889. Scrivner & Boone, attorneys for def't in error. Smith, Wright & Pomeroy, attorneys for plaintiff in error, 212 Sansome street, San Francisco.

Endorsed on cover: N. California C. C. U. S. No. 1198. The Oregon Improvement Company, plaintiff in error, *vs.* The Excelsior Coal Company. Filed August 14, 1889.

FILED
OCT 12 1889
JAMES. H. McKENNEY.
CLERK.

BRIEF FOR PLAINTIFF IN ERROR.

Supreme Court of the United States.

October Term, 1889.

No. 1198.

THE OREGON IMPROVEMENT COMPANY, PLAINTIFF IN ERROR,

vs.

THE EXCELSIOR COAL COMPANY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF CALIFORNIA.

FILED ..... 1889.

In the Supreme Court of the United States.

October Term, 1889.

No. 1198.

THE OREGON IMPROVEMENT COMPANY, PLAINTIFF IN ERROR,

vs.

THE EXCELSIOR COAL COMPANY.

BRIEF FOR PLAINTIFF IN ERROR.

Statement.

This was a common-law action for damages for an alleged infringement of certain reissued letters patent for an "Improvement in Coal Screens and Chutes." The case was tried before the Honorable Geo. M. Sabin, District Judge of Nevada, with a jury, and resulted in a verdict of $7,000 against the defendant in the action, now plaintiff in error.

The only question involved is, whether under the pleadings the learned Judge properly rejected the original letters patent, when offered at the trial as evidence on behalf of the defendant.

The state of the pleadings (so far as affects the question), was as follows:

The complaint alleged (Tr. Record, pp. 1–2) that "on the 17th day of June, 1873, * * letters patent of the United States, numbered 140,077, were issued to Martin R. Roberts, for the said invention * *. That said letters patent were issued in due form of law, under the seal of the Patent Office, and were signed * and countersigned * ", &c., &c. "That afterwards, to wit, on the 10th October, A. D. 1876, *upon due application* therefor, and upon the surrender * * of the letters patent last aforesaid, new letters patent *were duly issued* * * *for the same invention*, for the residue of the term then unexpired for which the original letters patent were granted * * *whereby there was secured to him* (Roberts) *the exclusive right and liberty of making, constructing, using and vending to others to be used, the said invention heretofore mentioned, a description* whereof and *of said invention more fully appears in said (reissued) letters patent*" produced. "*That prior * * * to the issue of said reissued letters patent, all proceedings were had and taken which were required by law to be had or taken previous to the * reissue of letters patent*," &c.; and that the defendant infringed upon the said reissued letters patent.

The answer (Tr. Record, p. 4) pleaded the general issue, in the following form: "Now comes the defendant, and answering the complaint on file in the above entitled action, denies each and every, all and singular, the allegations therein contained;" and further answering, charged that the apparatus covered by the reissued letters patent was not an invention when produced.

On the trial, the plaintiff in the case offered and read in evidence, without objection, the *reissued* letters patent (numbered 7,341), dated October 10th, 1876, and referred to in his complaint. The specification forming part of these reissued letters, contained a description and drawings of a "combined portable hopper chute and screening apparatus," and made FIVE separate claims. (Tr. Record, pp. 6, 7, 8, 9.) (For the convenience of the Court, we have elsewhere in this brief printed this specification alongside the specification of the original letters patent.)

The plaintiff also introduced evidence tending to prove that the defendant had infringed upon these letters patent by making a number of coal screens and chutes (but whether the supposed infringement was upon all of the claims of the reissued letters, or only upon some one or more of them, does not appear), and having introduced evidence tending to show the amount of damage done to it by the alleged infringement, the plaintiff rested its case.

Whereupon, the defendant offered in evidence a duly certified copy of the original letters patent numbered 140,077, dated June 17th, 1873, in favor of Martin S. Roberts, and mentioned in the plaintiff's complaint. The counsel for the plaintiff "objected to the introduction of the original letters patent on *the ground that the same was* (were) *immaterial and irrelevant to any defense raised by the answer.*" "The Court sustained the objection, and defendant's counsel excepted." (Tr. Record, pp. 9–10.)

Error Assigned.

The rejection of this evidence is assigned for error. (Tr. Record, p. 16.) As the most ready and convenient way of exhibiting the full substance of the rejected evidence, we print the specification of the original letters patent so rejected side by side with the specification of the reissued letters already in evidence. (The italics used in the original are intended to indicate matter excluded from the reissue, and capitals used in the reissue are intended to indicate matter not found in the original.) The drawings used in each were identical.

Fig. 1

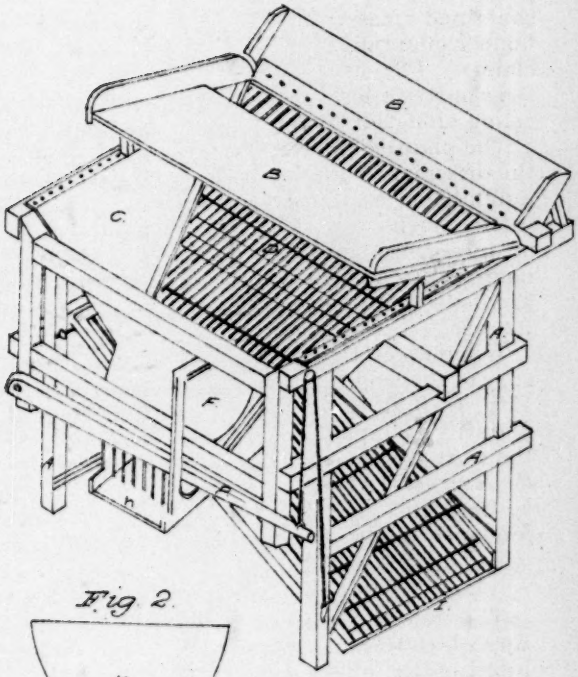


Fig. 2

(ORIGINAL—*Excluded from Evidence.*)

MARTIN R. ROBERTS, of San Francisco, California.

Improvement in Coal Screens and Chutes.

Specification forming part of Letters Patent, No. 140,077, dated June 17, 1873; application filed April 26, 1873.

To all whom it may concern :

Be it known that I, Martin Rickard Roberts, of San Francisco City and County, State of California, have invented a combined portable hopper, chute and screening apparatus ; and I do hereby declare the following description and accompanying drawings are sufficient to enable any person skilled in the art or science, to which it most nearly appertains, to make and use my said invention *or improvement* without further invention or experiment.

My invention relates to a portable apparatus, which is intended more particularly for receiving, cleaning and delivering into carts coal and other like substances, which are usually dumped upon the wharf in discharging ships.

The usual method of discharging ships of their cargo of coal is to raise the coal from the vessels in tubs, by a steam-hoisting apparatus, and dump it in a pile upon the wharf, from which it is removed by carts to the different coal-yards, where it is screened so as to separate the finer portion or screenings from the large and marketable or merchantable portion.

(REISSUE—IN EVIDENCE).

MARTIN R. ROBERTS, of San Francisco, California.

Improvement in Coal Screens and Chutes.

Specification forming part of Letters Patent No. 140,077, dated June 17, 1873; Reissue No. 6,211, dated January 5, 1875 ; Reissue No. 7,341, dated October 10, 1876 ; application filed July 10, 1876.

To all whom it may concern:

Be it known that I, Martin R. Roberts, of the City and County of San Francisco and State of California, have invented CERTAIN NEW AND USEFUL IMPROVEMENTS IN a combined portable hopper, chute, and screening apparatus; and I do hereby declare the following description and accompanying drawings are sufficient to enable any person skilled in the art of science, to which it most nearly appertains, to make and use my said invention, without further invention or experiment.

PREVIOUS TO MY INVENTION, IN UNLOADING VESSELS OF COAL, THE COAL HAS, FOR THE MOST PART, BEEN HOISTED FROM THE HOLD OVER THE BULWARKS AND DUMPED UPON THE WHARF OR UPON THE COAL, PREVIOUSLY DUMPED, OR, IF CHUTES WERE USED, SUCH CHUTES WERE FIXED ; NOR, SO FAR AS I AM AWARE, HAS A MOVABLE CHUTE EVER BEEN KNOWN OR USED BY WHICH THE COAL COULD BE RECEIVED FROM THE VESSEL AT ANY POINT IN THE WHARF, AND BE SCREENED AND DELIVERED TO THE CART.

My invention consists of a portable apparatus *having a double hopper, chute and screens, so arranged that by dumping the coal or other substances to be handled from the tub into the upper hopper the small quantities will be separated in two or more grades from the coarser portions, and be deposited in separate piles, while the coarser pieces are caught in the second hopper, from which they can be conveyed through a chute into the carts which convey them to the coal-yards, thus requiring but one operation to discharge the cargo, screen the coal, and load it into the carts.*

In order to more fully illustrate and explain my invention, reference is had to the accompanying drawings, forming a part of this specification, in which

Figure I is a perspective view of my invention. Fig. II is a plan view of the blank to be used when the apparatus is used only as a chute.

A A represent a strong frame, which is properly stayed and braced so as to withstand the concussions to which it will be subjected. At one side of the top of this frame, I secure two boards (B B), at an obtuse angle to each other, in the form of a trough, but leave their lower ends separated so as to provide a space (C), between them, for the purpose hereinafter described. These boards form what I call the *upper* hopper. The board (B) forms an extension to one side (D), of a large *hopper* (O), which is located in

My invention consists of a portable apparatus FOR RECEIVING COAL FROM THE BUCKET BY WHICH IT IS HOISTED FROM THE HOLD OF A SHIP, AND FOR SCREENING AND DELIVERING IT TO CARTS ON THE WHARF, SAID APPARATUS BEING ADAPTED FOR READY REMOVAL, FROM PLACE TO PLACE, WHEN REQUIRED.

BY THIS APPARATUS I AM ABLE TO SAVE REPEATED HANDLINGS AND CONSEQUENT EXPENSE, AND THE BREAKAGE OF THE COAL, AND THE APPARATUS CAN BE CHANGED FROM ONE POINT TO ANOTHER, WHERE THE VESSEL MAY BE PLACED.

THERE ARE FURTHER AND SUBORDINATE OBJECTS TO BE SECURED BY MY INVENTION AND THE IMPROVED DETAILS DEVISED FOR THESE PURPOSES WILL BE SET FORTH MORE FULLY HEREAFTER.

IN THE DRAWINGS, A A represent a strong frame, which is properly stayed and braced, so as to withstand the concussions to which it will be subjected. At one side of the top of this frame I secure two boards (B B) at an obtuse angle to each other, in the form of a trough, but leave their lower ends separated, so as to provide a space (C), between them, for the purpose hereinafter described. These boards form what I call the hopper. The board (B), forms an extension to one side (D) of a large RESERVOIR (O),

the body of the frame, below the *upper* hopper. This side, (D), of the large *hopper* slopes toward the opposite side of the frame, and is constructed of parallel wires, secured at short distances apart, so as to form a screen over which the coal or other substance must pass in descending from the *upper to the lower hopper*, and through which the small particles, up to a certain size, will fall, leaving the larger pieces, which cannot pass through the screen, lying in the second or large hopper. The *lower hopper* is contracted toward its lower end, and a chute (F) extends from it out over the opposite side of the frame from that on which the upper hopper is located. A gate (h), which will be more fully described hereafter, serves to retain the coal in the chute and *hopper*, until it is desired to allow it to pass from the chute into a cart or other vehicle. An independent grate or screen (I), of finer mesh than the grate (D), is secured in an inclined position in the frame (A A), below the screen (D), so as to receive the particles of coal or other substance which pass through the upper screen, and which serves to again separate it into two grades. This screen stands at an angle transversely to the upper screen, so that the particles which pass down it, on account of not being small enough to pass through the meshes, will be carried off to one side of the machine, while the finer portions, which pass through the screen, will fall

which is located in the body of the frame, below the hopper. This side (D) of the large RESERVOIR slopes toward the opposite side of the frame and is constructed of parallel wires, secured at short distances apart, so as to form a screen over which the coal or other substance must pass in descending from the HOPPER TO THE RESERVOIR, and through which the small particles, up to a certain size, will fall, leaving the larger pieces, which cannot pass through the screen, lying in the second or large hopper. The RESERVOIR is contracted toward its lower end, and a chute (F), extends from it out over the opposite side of the frame from that on which the upper hopper is located. A gate (h), which will be more fully described hereafter, serves to retain the coal in the chute and RESERVOIR until it is desired to allow it to pass from the chute into the cart or other vehicle. An independent grate or screen (I), of finer mesh than the grate (D), is secured in an inclined position in the frame (A A), below the screen (D), so as to receive the particles of coal or other substance which pass through the upper screen, and which serves to again separate it into two grades. This screen stands at an angle transversely to the upper screen, so that the particles which pass down it, on account of not being small enough to pass through the meshes, will be carried off to one side of the machine, while the finer portions, which pass through the

upon the floor or wharf directly under the frame.

Two or more of the screens can be used, and the size of the meshes can be varied, according to the substance to be cleaned and the number and quality of the grades into which it is desired to separate the substance being discharged.

The frame (A A) will be mounted upon small wheels, so that it can be moved from one place to another upon a wharf, in order to be placed in position to receive the discharging cargos of different ships; but when moving it from one wharf to another, I employ axles across each end of the frame, upon which strong wheels are placed, so that the entire machine can be drawn along similar to any *wheeled* vehicle.

The upper trough, which is formed by the boards (B B) is as long as the machine, *so that in dumping the load any vibration or swinging of the tub, while it is being emptied, will not cause the load to be discharged outside of the hopper, as long as the machine is properly located and ordinary care is exercised in dumping it. This form of the upper hopper also allows the substance which is dumped into it, to spread over a large surface, and thus be thoroughly screened than when the hopper is smaller.*

screen, will fall upon the floor or wharf directly under the frame. Two or more of these screens can be used, and the size of the meshes can be varied according to the substance to be cleaned and the number and quality of the grades into which it is desired to separate the substance being discharged.

The frame (A A) will be mounted upon small wheels, so that it can be moved from one place to another, upon a wharf, in order to be placed in position to receive the discharging cargos of different ships; but when moving it from one wharf to another, I employ axles across each end of the frame, upon which strong wheels are placed, so that the entire machine can be drawn along similar to any vehicle.

The HOPPER (B B) is as long as the machine, AND IS MADE WIDE, SO THAT WHEN ORDINARY CARE IS USED IN DUMPING, IT IS CERTAIN TO CATCH ALL THE COAL POURED FROM THE SWINGING TUB. THIS HOPPER IS ALSO PLACED HIGH ON THE MACHINE, AND BUT SLIGHTLY ABOVE THE INCLINED SIDE OF THE RESERVOIR, SO THAT THE COAL HAS BUT A SHORT DISTANCE TO FALL, AND IS THEREBY PREVENTED FROM BEING BROKEN AND PULVERIZED. THE OUTLET OF THE HOPPER (B B), EXTENDS ENTIRELY ACROSS THE UPPER END OF THE SIDE OR SCREEN (D), BY WHICH ARRANGEMENT THE PASSING COAL IS DISTRIBUTED OVER THE ENTIRE WIDTH OF D, AND HAS TO PASS ITS ENTIRE LENGTH,

When it is not desired to screen the article or substance to be unloaded, a false bottom or metal blank (K), is placed upon the grating or inclined side (D) of the *larger hopper*, so that the substance will be carried directly through the chute into the cart or wagon intended to convey it away.

The gate or cut-off which I use consists of a lever bar (p), which has one end pivoted to the frame, so that it will extend

THUS INSURING A THOROUGH SCREENING OF THE COAL. THE CONSTRUCTION AND LOCATION OF THIS HOPPER (B B), MAKE IT A SUCCESS IN RECEIVING THE CONTENTS OF THE BUCKET BY WHICH THE COAL IS HOISTED FROM THE HOLD OF THE VESSEL, A RESULT WHICH I BELIEVE WAS NEVER BEFORE ACCOMPLISHED BY ANY HOPPER.

BY PLACING THE RESERVOIR (O) IN ITS PECULIAR POSITION, AND MAKING IT LARGE, SEVERAL ADVANTAGES ARE OBTAINED. AMONG OTHERS, A LARGE SCREENING SURFACE IS OBTAINED. THE GATE (h) IS SUFFICIENTLY HIGH FROM THE WHARF TO ALLOW VEHICLES TO BE PLACED SO AS TO RECEIVE THE COAL DIRECT AS IT IS DISCHARGED FROM THE CHUTE, SO AS TO SAVE RELOADING IT FROM THE WHARF; AND THE RESERVOIR (O) IS LARGE ENOUGH TO SERVE AS A STORE-ROOM, SO THAT, IN CASE OF TEMPORARY DELAY, IN THE VEHICLE CARRYING THE COAL TO THE YARDS, THE WORK OF UNLOADING THE SHIP OR OTHER VESSEL CAN PROCEED WITHOUT THE NECESSITY OF PILING THE COAL UPON THE WHARF.

When it is not desired to screen the article or substance to be unloaded, a false bottom or metal blank (K), is placed upon the grating or inclined side (D) of the RESERVOIR, so that the substance will be carried directly through the chute into the cart or wagon intended to convey it away.

The gate or cut-off which I use consists of a lever-bar (p), which has one end pivoted to the frame, so that it will extend

transversely across, above the end of the chute. Metal teeth (h), extend downward across the mouth of the chute, so as to bar the entrance. When the cart is in position beneath the chute, the free end of the lever is raised so as to clear the teeth from the mouth of the chute, and allow the substance to pass through by its gravity into the cart.

By this arrangement coal can be discharged from ships, screened and loaded into carts, not only at a great saving of expense in handling it, but with less wastage, as the large and more marketable pieces or lumps will not be broken when dumped into this machine, as they always are, to a greater or less extent, when dumped from the height of twenty or thirty feet upon the wharf or coal pile.

Having thus described my invention, what I claim, and desire to secure by letters patent, is—

transversely across above the OTHER end of the chute. Metal teeth extend downward across the mouth of the chute, so as to bar the entrance. When the cart is in position beneath the chute, the free end of the lever is raised so as to clear the teeth from the mouth of the chute, and allow the substance to pass through its gravity into the cart.

FROM THE PRACTICAL SUCCESS WHICH HAS ATTENDED MY INVENTION I BELIEVE ITS INTRODUCTION WILL MAKE IT PROFITABLE TO SHIP OTHER SUBSTANCES, SUCH AS COBBLE-STONES, GRAVEL, ETC., AND ASSORT THEM WHILE UNLOADING THE SHIP.

By this arrangement, coal can be discharged from ships, screened, and loaded into the carts, not only at a great saving of expense in handling it, but with less wastage, as the large and more marketable pieces or lumps will not be broken when dumped in this machine, as they always are, to a greater or less extent, when dumped from the height of twenty or thirty feet upon the wharf or coal pile.

Having described my invention, what I claim, and desire to secure by letters patent, is—

1. A PORTABLE COMBINED COAL RECEIVING, SCREENING AND DELIVERING APPARATUS, ARRANGED TO RECEIVE THE COAL OR OTHER CARGO FROM A SWINGING SUSPENDED TUB OR BUCKET, BY WHICH IT IS HOISTED FROM THE HOLD OF A SHIP OR OTHER WATER-CRAFT, AND TO SCREEN IT AUTOMATICALLY AND DELIVER IT INTO CARTS, SAID APPARATUS BEING CONSTRUCTED AND ARRANGED SUBSTANTIALLY AS DESCRIBED.

1. The receiving hopper (B B), in combination with the *hopper* (O). with its screen or grating side (D),. chute (F), with its toothed gate (h), and one or more independent screens (I), all combined and arranged substantially as and for the purpose above described.

2. The metal blank or false bottom (K), in combination with the receiving hopper (BB), *hopper* (O), chute (F), and gate (h), substantially as and for the purpose above described.

In witness whereof, I hereunto set my hand and seal.

M. R. ROBERTS, [L. S.]

Witnesses :

GEO. H. STRONG,
HENRY K. MOORE.

2. The receiving-hopper (B B), in combination with the RESERVOIR (O), with its screen or grating side (D), chute (F), with its toothed gate (h), and one or more independent screens (I), all combined and arranged substantially as and for the purpose above described.

3. The metal blank or false bottom (K), in combination with the receiving-hopper (B B), RESERVOIR (O), chute (F), and gate (h), substantially as and for the purpose above described.

4. THE COMBINATION OF THE HOPPER (B B), FOR RECEIVING THE COAL FROM A SWINGING BUCKET, THE RESERVOIR (O), ARRANGED TO RECEIVE THE COAL AS IT PASSES FROM THE HOPPER, WITH THE CHUTE (F), AND GATE (h), ALL CONSTRUCTED TO OPERATE SUBSTANTIALLY AS AND FOR THE PURPOSE SET FORTH.

5. IN COMBINATION WITH THE ELONGATED HOPPER, THE SCREEN (D), RESERVOIR (O), AND CHUTE (F), WITH ITS GATE (h), THE COMBINATION BEING SUBSTANTIALLY AS IS HEREIN SET FORTH.

MARTIN R. ROBERTS.

Witnesses:

J. L. BOONE.
CHAS. G. PAGE.

Points of Law and Fact.

I.

THE RULING COMPLAINED OF WAS ERROR UNDER THE DECISION IN MARSH *vs.* NICHOLS, SHEPARD & CO., 128 U. S. REPORTS, 605.

In *Marsh* vs. *Nichols*, it appears from the report (pp. 605–606), that the state of the pleadings was as follows: "The bill sets "forth that the alleged patent was obtained on the 28th day of "December, 1880, and was in due form of law, under the seal of "the Patent Office of the United States, signed by the Secretary "of the Interior, countersigned by the Commissioner of Patents, "and dated on that day and year. The answer of the defendant "to the allegations is, that it knows nothing of the issue of the "patent except as informed by the bill, or by hearsay, and "therefore neither admits nor denies them, but leaves the com-"plainants to make such proofs thereof as they may deem ad-"visable."

Delivering the opinion of the Court, Mr. Justice Field said (p. 609):

"In support of their appeal, the appellants contend in sub-"stance, as follows:

"1st. That the defendant could not impeach the patent for "the irregularity in its signing and issue, this not being appar-"ent on its face, without pleading such defense and *regularly* "putting the question in issue.

"2nd. That the patent being regular on its face, evidence to "show that the signature was irregularly placed to it, was in-"competent," &c., &c.

In considering these positions, the learned Justice (pages 610–611 of the report) said: "It is always open to show that an "instrument produced in evidence, whether in action at law, or "in a suit in equity, in support of a claim or defense, was never "executed by the person whose signature it bears, but that it is "a simulated and forged document." * * * And "we have "also held that if the land patented was never the property of "the United States * * * *or the officers had no authority to "execute the instrument, the fact could be shown in any action or "proceeding whenever the patent is offered in evidence.* * * * "This doctrine has special force in its application to a patent "for an invention," &c., &c.

The Court, in this opinion, nowhere refers to, or purports to apply any rule of pleading. It seems to rest the right to attack the patent for the causes pointed out entirely on the fact that the patent was already in evidence as part of the complainant's case, and its validity was not expressly admitted by the answer.

In the present case, however, the complaint alleges (as we have shown), among other things (Tr. Record, pp. 1 and 2) that "new letters patent were duly issued to said Martin R. Roberts *for*

" *the same invention* * for which the said original letters pat-
" were granted;" and "also, prior to the issue of said reissued
" letters patent *all proceedings were had and taken which were re-*
" *quired by law to be had or taken, previous to the* * *reissue of let-*
" *ters patent.*"

The answer *denied* (Record, p. 4) *each and every, all and singular* of these allegations, and further alleged that the apparatus covered by the reissued letters patent issued to Martin R. Roberts was not an invention when produced by the said Roberts.

The issues thus raised seem to us to have been perfectly plain:

1. Were the original and reissued letters *for the same invention?*

2. Were all the proceedings, required by law, taken before the issuance of the reissued letters patent?

3. Was the apparatus *covered* by the reissued letters patent an invention *when produced* by Roberts?

In respect to the first of these issues, it is difficult to conceive how proper proof could be offered that an original and reissued patent were not for the same invention without first producing both documents and comparing them.

In respect to the second of these issues, it is, we think, well settled now that the law requires the surrender of original letters patent *that are inoperative or invalid, by reason of a defective or insufficient specification* before the Commissioner possesses authority to grant new letters patent for the same invention. The exhibition of the original letters patent is surely proper to show that they were not inoperative, invalid, defective or insufficient.

And in respect to the third of these issues, we think it plain that if an "apparatus covered by the reissued letters patent," was not claimed by Roberts when he applied for and obtained his original letters patent, his failure to do so must arise from one of three causes, viz.: (1) he did not then regard it as an invention, or (2) he intended to abandon it to the public, or (3) he omitted to claim it through inadvertence. The original letters patent were certainly material and relevant evidence to establish the existence of the first, if material and relevant to establish either of the other of these causes. In other words, to show, in the language of our answer that the "apparatus now covered was not an invention when produced."

We do not deem it necessary, in view of doctrines so often of late reiterated by this Court, to argue to the materiality of these issues. We may be permitted to say, however, that the language of the Court in the case of *Mahn* vs. *Harwood*, at pages 358 *et seq.* of the 112th Volume of the Reports, best asserts the value of these defences, from which we were excluded.

II.

THE COURT CANNOT SEE AFFIRMATIVELY, AND BEYOND DOUBT

THAT THE ERROR COMPLAINED OF WORKED NO INJURY, AND THEREFORE IT WILL REVERSE THE JUDGMENT.

Gilmer vs. *Higley*, 110 U. S., 47.
Maryland vs. *Baldwin*, 112 U. S., 493.
Vicksburg & Meridian R. R. vs. *O'Brien*, 119 U. S., 103.

In view of this rule, we deem that we are relieved from the necessity of offering a close (and consequently extended) analysis and comparison of the two patents. We take leave to add, however, in imitation of the method pursued by the Court in *Gilmer* vs. *Higley*, that it is apparent upon the face of the original letters patent that if they had been allowed in evidence, "it is probable they would have very strongly supported" our answer. The reissued letters, already in evidence, contained five claims, among them one (No. 1) covering *any conceivable portable* combined coal-receiving, screening and delivering apparatus arranged to receive coal or other cargo from a swinging, suspended tub or bucket, by which it is hoisted from the hold of a ship and delivered into carts (Record, p. 9), whereas the specification of these very reissued letters patent elsewhere (Record, p. 7), admits by implication, that "previous to my invention," chutes *of some kind* were used by which coal could be received from a vessel and screened and delivered into carts. The original letters, though more than four years older, were entirely without such a claim.

Had the original letters patent been admitted in evidence, and were there no other evidence of the state of the art than these two patents, the silence of the original on the subject of the broad claim first appearing in the reissue was at least matter of defense upon which the plaintiff in error might have been heard to his advantage. But were there additional proofs before the jury as to the state of the art, it is easy to perceive that the original letters patent, by their failure to make this claim, might have been conclusive evidence of over-reaching and fraud in the reissue.

The doctrines announced by this Court in *Miller* vs. *The Brass Co.* (104 U. S., 350), explained with further elaboration in *Mahn* vs. *Harwood* (112 U. S., pp. 358, *et seq.*) and applied since in more than 20 different cases by this Court, cannot be of much avail to stem the current of over-reaching for which they were designed, if at the threshold of inquiry Courts, as in the present case, through over-nice doubt of the form of pleading shrink from their application.

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Office Supreme Court U. S.
FILED.
OCT 28 1889
JAMES H. McKENNEY,
CLERK.

BRIEF IN REPLY FOR PLAINTIFF IN ERROR.

Supreme Court of the United States.

October Term, 1889.

No. 1198.

THE OREGON IMPROVEMENT COMPANY, PLAINTIFF IN ERROR,

vs.

THE EXCELSIOR COAL COMPANY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF CALIFORNIA.

FILED ..... 1889.

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v.

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BRIEF IN REPLY FOR PLAINTIFF IN ERROR.

I.

The twenty-first rule of this court, regulating the form of briefs, requires the plaintiff in error, when the error alleged is to the admission or rejection of evidence, to "quote the full substance of the evidence admitted or rejected." This provision, like every other provision of the rule, appeared to us to be intended to enable the court to weigh the evidence without tedious recourse to the transcript. We consequently complied in our former brief with the spirit as well as the letter of the rule by quoting in full the rejected specification of the original letters patent, and placing it in convenient juxtaposition with the specification of the reissued letters. Plainly overlooking the rule, counsel for defendant in error assert in their brief, that "until it [the specification of the original letters patent] is admitted in evidence it has no business before the jury or court, either at the trial or on the appeal," and "contend that it is presumption if not an attempt to secure an undue advantage by prejudicing the minds of the court to interject them into their [our] brief."

We should not heretofore have believed that counsel could be found anywhere in the United States apprehensive that their opponents could be guilty of presumptuousness towards this court.

II.

The "general denial" pleaded by the defendants in the court below is not the "general issue" known to the common law. The "general denial" is broader in its scope than was "the gen-

eral issue," and scientifically puts in issue ALL of the allegations of the declaration in such an action as the present. The whole of the force allowed to a general denial under the codes is preserved to it in common-law actions in the United States courts by the provisions of section 914 of the Revised Statutes of the United States; hence it follows that the defendant in the court below was entitled to disprove any and all of the averments of the declaration.

Professor Pomeroy, in his work on Remedial Rights and Remedies, points out the distinction between the modern "general denial" and the old "general issue" with great particularity. At section 656 he says:—

"There are a few points which should be noticed in relation to the foregoing rules, which govern the use of the general issue. In the first place, there was no uniformity in its operation. Its effect as a pleading, its extent and scope in the admission of various defenses, did not depend upon any qualities inherent in itself, but resulted rather from the particular form of action in which it was employed. In the second place, the formula which was adopted in these different actions did not in any single instance purport, according to the literal import of the language, to answer and deny all the allegations of fact contained in the declaration, and which together made up the plaintiff's cause of action, but rather singled out and contradicted some particular one of these averments. As, for example, it denied the promise in *assumpsit*, the execution of the deed in covenant, and in one species of debt, the commission of the acts complained of in case and in trespass. Even in the single instance of *nil debet*, where issue seems to be taken by the express terms of the plea with the entire cause of action, the denial was not directed to the facts, but rather to the legal conclusion which arises from these facts.

"In the third place, this answer, in its practical operation, was miscalled the 'general issue,' for it ranged through almost every possible degree of efficacy. In some instances, it did not put in issue all the allegations of the declaration, and was therefore far less than a general denial; in other instances, it not only put in issue all the allegations of the declaration, but also admitted proof of nearly all the defenses which the defendant could rely upon, and thus united in itself all the possible denials, and almost all the matters of affirmative defense, which could be used to defeat the plaintiff's recovery. In no single instance did it perform the exact functions of the general denial; that is, in no case did it barely put in issue all the averments of the declaration compelling the plaintiff to prove them, and permitting the defendant to disprove them. It either fell short of or went far beyond this natural and, as it seems to me, strictly logical office and function. In this respect, the theory of pleading embodied in the codes is more severely scientific as well as more simple and practical than that which lay at the basis of the common-law system."

At section 650, Professor Pomeroy points out that the general issue in actions on the case was termed "not guilty"; but that even under this narrow form of issue in time, "any matter which showed that the plaintiff ought not in justice to recover might in general be proved."

And at section 643, he says: "Undoubtedly, much of the confusion, redundancy, and unscientific character of the pleadings under the codes is the result of ignorance or uncertainty as to the power of the general denial to admit defenses upon which the defendant relies. In very many instances, the answer is made a long and rambling mass of purely evidentiary details, when the simple general denial, not exceeding two or three lines in length, would be fully as efficacious, and would present the issue in a sharper and clearer manner."

The defendant in this action put in a general denial in the following form: "Now comes the defendant, and answering the complaint on file in the above-entitled action, denies each and every all and singular the allegations therein contained." (Tr. Record, p. 4.) Among other allegations of the complaint as pointed out in our former brief were allegations: 1. That plaintiff made "due application" for the reissued letters; 2. That the "new letters patent were duly issued for the same invention"; 3. That "all proceedings were had and taken which were required by law to be had or taken previous to the reissue of letters patent."

We do not doubt that under such pleadings the reissued letters patent, when put in evidence, would constitute *prima facie* proof of the regularity of their issuance; but upon what reasonable ground can it be questioned that the defendant might not then disprove this *prima facie* case by evidence that the original letters patent were not inoperative or invalid by reason of a defective specification or evidence that the original letters patent were for a different invention? Surely it will not do for a modern practitioner to say that he is surprised by the offer of such evidence under such pleadings.

For the views expressed by Mr. Walker, and quoted in the brief for defendant in error, we are unable to find any support in the adjudications of this court. On the contrary, we believe them to be expressly repudiated by the decision in the case of *Marsh* v. *Nichols* (128 U. S. Reports), heretofore cited by us. Mr. Walker, moreover, argues entirely from analogy, and yet appears to have overlooked the fact that section 4920 of the Revised Statutes treats only of the use to which a defendant may put the old plea of the "general issue" *if he chooses to plead it*, and nowhere prohibits the use of the modern "general denial," or limits its effect if it shall be pleaded. Moreover, he does not reflect that section 914 expressly permits "the practice, pleadings, and forms and modes of proceedings" in the United States courts in common-law cases to "conform as near as may be to the practice,

pleadings, and forms and modes of proceeding existing at the time" in the state.

We respectfully submit that our pleading was sufficient to permit of the evidence offered.

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SAN FRANCISCO, CAL.

FILED
JAMES H. MCKE

BRIEF FOR DEFENDANT IN ERROR.

Supreme Court of the United States.

October Term, 1889.

No. 1198

THE OREGON IMPROVEMENT COMPANY, PLAINTIFF IN ERROR.

vs.

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THE EXCELSIOR COAL COMPANY, DEFENDANT IN ERROR.

Printed Argument of Defendant in Error.

The judgment appealed from was entered on a verdict rendered by a jury on the 18th day of September, 1888, in the United States Circuit Court, within the Northern District of California.

The plaintiff was and is the owner of Re-issued Letters Patent No. 7341, dated October 10th, 1876, and issued to Martin R. Roberts for "Improvements in Coal Screens and Chutes."

The suit was based on the re-issued patent, and the judgment was in favor of the plaintiff in the sum of $7000.

This appeal is based upon a single alleged error (see Assignment of Errors, Page 16, Section 26, Transcript), viz: "That the Court refused to allow plaintiff in error " to introduce in evidence *to sustain the issues on its part* " the aforesaid duly certified copy of the original letters " patent Number 140,077, dated June 16th, 1873, in favor " of the aforesaid Martin R. Roberts, for an Improve- " ment in Coal Screens and Chutes."

The whole record on which appellant relies is before the Court. Defendant's answer is found on page 4 of the transcript. This answer is simply (1) a general denial of all the allegations of the complaint; (2) a denial that the apparatus covered by the re-issued patent *was an invention* when produced by the patentee Roberts, and (3) a denial relating to another patent not involved in the appeal.

It is apparent, therefore, that the only issues raised in the case, as far as the Roberts patent is concerned, are raised by the denials numbered 1 and 2, in the Assignment of Errors.

Counsel has produced in their brief a copy of the specification of the re-issued letters patent alongside a copy of the specifications of the original letters patent. What their purpose in doing this was, is not apparent, unless it be to covertly raise a prejudice in the minds of the Court against the re-issue. The questions raised by the appeal does not make it necessary for the Court to compare these specifications, and we feel assured that the Court will not do so, even though counsel has, by inserting them in their brief, forced them before the eyes of the Court.

The question presented to the Court is, "Ought the original patent to have been admitted in evidence at the trial? Until it is admitted in evidence, it has no business before the jury or Court, either at the trial, or on the appeal. The question presented is purely and wholly a question of law, and we apprehend that it will be decided as such. It was presented to the Judge of the trial Court as a question of law. It was decided by that Judge as a question of law, and we shall treat it in our argument as a question of law. Should the original patent be properly introduced in evidence, so that it shall be before the Court for the purpose of comparing it with the original patent, it is time then to compare them ; but until it is so properly introduced, it is error to make any comparison of them whatever, and we contend that it is presumption, if not an attempt to secure an undue advantage, by prejudicing the minds of the Court, to interject them into their brief.

WAS THERE ANY ISSUE RAISED BY THE ANSWER THAT WOULD JUSTIFY THE ADMISSION OF THE ORIGINAL PATENT IN EVIDENCE?

The theory of the law is, that a patentee has a right to rely upon the patent issued to him by the Govern-

ment, unless *in any suit for infringement of a patent.* Where *the validity* of his patent is to be questioned, he shall have thirty days' notice of the matter to be charged against its validity. The Courts have held that the object of this notice is to prevent the patentee from being taken by surprise. If the validity of his patent is to be attacked, a patentee should have timely notice of the fact, so that he may prepare to meet it.

It would be an unjust and unheard of proceeding to allow a defendant in a patent case, without previous notice, to attack the *prima facie* case made out by the introduction of a patent, by rising and attacking its validity, before a jury, in the midst of a trial, *when the patentee has no time or opportunity to prepare to meet the attack.* The patentee has a right to rely on his patent, until due and proper notice is given to him that its validity is to be assailed. Had such notice been given in this case the offer to introduce the original patent would not have been denied.

DOES A GENERAL DENIAL, WITHOUT NOTICE, RAISE ANY ISSUE THAT WOULD JUSTIFY THE COURT IN ADMITTING THE ORIGINAL LETTERS PATENT IN EVIDENCE?

A general denial simply puts in issue the matters which are properly pleaded in the complaint.

The suit in this case is based upon a *re-issued* patent.

The *original* patent is set out merely by way of *a foundation for pleading the re-issue.*

No profert of the original patent is made in the complaint.

No demand of oyer was made by the defendants.

No demurrer was interposed by the defendant to the Complaint, based on the want of profert.

If profert of the original patent had been made in the complaint, the defendant could then, by a demand of oyer, have made the original patent a part of the pleading, *and it would then have been in the case.*

If the Complaint contained no profert of the original patent, *defendant could have demurred to the Complaint,*

and compelled an amendment in that respect, *and it could then have demanded oyer.*

It was therefore open to defendant, if it desired to attack the validity of the re-issued patent, to make it a part of the complaint, and in that case a general denial would have been sufficient.

But as we have seen, defendants evinced no disposition to attack the validity of the re-issued patent, *until the case was in the midst of trial before a jury,* when plaintiff had no chance to prepare to meet it.

Plaintiff had a right to rely on the *prima facie* validity of his re-issued patent under this state of facts. (*Phila. & Trenton R. R. Co. vs. Stimpson, 14, Peters, 448.*)

The re-issued patent is *prima facie* proof of certain facts. (*U. S. & Foreign Salamander Felling Co. vs. Haven, 3 Dill., 131.*)

It is *prima facie* evidence of all the facts that the original patent is *prima facie* proof of, and in addition it is also *prima facie* proof of two other facts : viz. (1) That the original patent was defective, and (2) that the invention described and claimed in the re-issued patent *is the same* as that described and claimed in the original patent.

Now if the re-issued patent is *prima facie* evidence of all the facts that the original patent is proof of, what object was there in admitting the original in evidence, unless it was to prove one of the two additional facts above stated? And this brings us to another rule of evidence, which is, that when a party offers a document in evidence, he must state the object for which it is offered, and he cannot use it for any other object.

The defense in this case, in offering the original patent in evidence, stated their object to be *to sustain the issues on its part.*

But we have seen that the same issues would be raised with reference to the re-issued patent that would be raised with reference to the original patent,* with the two exceptions above stated.

*The original patent could not certainly be introduced in evidence to sustain any issues that both the re-issued patent and original patent were *prima facie* proof of, because that would be merely producing *cumulative evidence*. It would then be apparent that the *only effect* of introducing the original patent would be to sustain the two issues, viz:

1. That the original patent was not defective, *and ought not to have been re-issued at all.*

2. That the re-issue is for a different invention, or, in other words, is not for the same invention as that described in the original patent.

These issues are entirely separate and distinct issues, and we were entitled to be notified *for which object and to support which issue the original patent was offered to be used.* Consequently we say that the offer, *under a general denial*, was insufficient, even admitting—which we do not—that it could be introduced under the general issue *without notice.*

We have, however, the authority of precedents that "the re-issued patent is *prima facie* evidence that it is "for the same invention as that of the original patent, "and that any subsequent inquiry before a Court and a "Jury is limited to the question of fraud."

Hussey vs. Bradley, 5 Blatch, 134.
Phil. & Trenton R'y Co. vs. Stimpson, 14 Pet., 448.
Stimpson vs. Westchester R. Co., 4 How., 380.
O'Reilly vs. Morse, 15 How., 62.
Battin vs. Taggart, 17 How., 74.
Woodworth vs. Stone, 3 Story, 749.

In *Doughty vs. West, 2 Fish, 553*, it was held that "allegations as to false representations in securing re-"issues should be made in distinct language, without "equivocation, and be the subject of very distinct proof."

No rule short of this would protect a patentee from gross wrong.

In *Seymour vs. Osborne, 11 Wall., 516*, which is a leading case, the suit was on a re-issued patent, and in that case it was held that "*thirty days' notice of defense as-*

"*sailing the validity of the patent is required.*" In that case, as in all other cases reported, wherein a re-issued patent has been assailed on the ground that it was not for the same invention as the original, thirty days' notice was given that such defense would be insisted upon.

We also have the authority of *Walker on Patents* that prior notice is necessary to enable the defense to obtain a judicial comparison of these two documents, viz: the re-issued and the original patents.

On page 320 and 321 of his valuable work on Patents, Walker mentions twenty-seven defenses that may be urged in a patent case. The 16th defense named in that connection is, "That the claims of the re-issue patent in "suit are broader than those of the original, and that the "re-issue was not applied for till a long time had elapsed "after the original was granted."

In speaking of this defense, on page 332 of the same work, Sec. 458, he says:

"The sixteenth defense originated in the year 1882, "and though not based on the letter of the statute, it has "already been many times enforced. The first element "in its foundation is a point of comparative construction "of the original and re-issued patent. But inasmuch as "a plaintiff suing on a re-issue need not introduce the "original in evidence, even that element depends upon "proof by the defendant of the contents of the original. "The second element is a variable quantity for the par-"ticular length of time between the date of an original "and the application for a re-issue patent, which will be "fatal to a broadened re-issue, depends upon the cir-"cumstances in each case, and those circumstances can "be made known to the Court through evidence alone. "THESE CONSIDERATIONS POINT TO THE PROPRIETY OF DIS-"REGARDING THIS DEFENSE IN AN ACTION AT LAW, UNLESS "IT IS SET UP IN A SPECIAL PLEA, AND THE PLAINTIFF THUS "NOTIFIED OF WHAT HE MUST MEET ON THE TRIAL."

The 17th defence named by Walker is "That the re-"issue patent in suit covers a different invention from

"any suggested, indicated or described in the original "specification or drawings."

Of this defense Walker says on page 332.

"§ 459. The seventeenth defense is among the most "common in patent litigation. It also depends upon "proof of the original patent and requires at least that "amount of evidence to support it. In cases where the "question of sameness or difference of invention is a com-"plicated one, courts will generally require the benefit of "evidence on that subject to aid them in deciding the "point. IN ORDER TO GIVE BOTH SIDES AN OPPORTUNITY TO "PRODUCE SUCH EVIDENCE, A SPECIAL PLEA IS NECESSARY TO "BE INSISTED UPON. Such a requirement is consistent al-"so with the practice in equity, where this defence has "been interposed on that side of the Court."

We contend therefore that the "general denial does not entitle the defendant to put in evidence the original patent for the purpose of comparing it with the re-issued patent sued on.

THE SECOND CLAUSE OF THE ANSWER.

But the second clause of the answer, viz., "That the "apparatus covered by the re-issue letters patent issued "to Martin R. Roberts on the 10th day of October. 1876, "*was not an invention when produced by the said Martin "R. Roberts*" still remains to be considered.

It admits that Roberts *did produce the invention* but denies that when he produced it it was an invention.

This is in fact a denial that Martin R. Roberts was the *original and first inventor* of the invention described and claimed in the re-issued patent.

This simple denial in a patent case is not sufficient to raise an issue. Section 4920, Rev. Stat. U. S., names five special defenses which may be urged by the defendants.

The fourth defense named in that section is the one above referred to. But the section says: "And in no-"tices as to proof of previous invention, knowledge or use "of the thing patented, the defendant shall state the

"names of the patentees, and the dates of their patents, "and when granted," etc.

No such notice was given, so that the issue raised by this denial was a useless issue.

But even if defendant could, under this denial introduce the original patent in evidence, how could that patent sustain or tend to sustain such issue? It could not be used to prove that Roberts *did not invent* what was described in the re-issue. *On the other hand its only effect would be the opposite.* It would show or tend to show that Roberts *did invent* the invention described and claimed in the re-issued patent.

Consequently the Court would not have been justified in admitting the original letters patent under this issue.

These are all the issues raised by the pleadings in this case under which any pretence of a right could be set up to establish error in the Court in refusing to admit the original patent in evidence, Counsel for appellant insist that the ruling of the Court was error under the decision in *Marsh vs. Nichols, Shepard & Co., 128 U. S. Rep.* 605.

We beg leave to differ.

That case merely decides that it may always be shown by a party to a suit that a document relied upon by the opposite party to establish a claim *"is a simulated and forged document."* That is correct law. No special plea is required to raise that issue.

Such, however, was not the issue in the case under discussion. The *bona fide* character of the re-issued patent was not questioned. The defense did not ask to introduce the original patent to prove that the re-issue patent was a "simulated or forged document." Their object was to attack the validity of a patent which they admitted to be a *genuine patent.* The object was to go behind the patent; the attack was a collateral attack and not a direct attack upon the patent, and in such cases the patent laws of the United States are very explicit that proper and due notice of the grounds of such attack must be given.

We submit, therefore, that the Court committed no error in refusing to admit the original patent in evidence.

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J. J. Scrivner
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